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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,717	10/17/2003	Heribert Schmitt-Willich	SCH-1540 DS	8822

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EXAMINER

SCHLIENTZ, LEAH H

ART UNIT PAPER NUMBER

1618

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,717	Applicant(s) SCHMITT-WILLICH ET AL.	
	Examiner Leah Schlientz	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16 and 27 is/are rejected.
- 7) ☒ Claim(s) 17-26 and 28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/17/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/674,844.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 14 - 16 of U.S. Patent No. 6,063,361 in view of Simor *et al.* (*Circulation*, 1995, 92, p. 3549-3559). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant cascade polymers are the same as those of the '361 patent (claim 1), which are utilized in a method for NMR diagnosis which comprises administering to a patient at least one cascade polymer complex and subjecting the patient to an NMR diagnosis. Thus, the same cascade polymer complexes are used for performing the same steps, which are performed on the same population. The '361 patent does not specifically

teach that the step of "performing NMR diagnosis on the patient" would also have the ability to identify underperfused regions in a human or animal patient. However, Simor *et al.* demonstrate the ability to detect underperfused myocardium in animals with a gadolinium containing contrast agent using MRI imaging techniques, and that the benefit of doing so is the visualization of myocardial ischemia (abstract). It is noted that MRI imaging would be within the scope of generic NMR imaging as claimed.

Claim 16 is also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 5,820,849 in view of Simor *et al.* Although the conflicting claims are not identical, they are not patentably distinct from each other because similar cascade polymers to the instant claim are utilized in a method for NMR diagnosis which comprises administering to a patient at least one cascade polymer complex (claim 9). The '849 patent does not specifically teach that the step of "performing NMR diagnosis on the patient" would also have the ability to identify underperfused regions in a human or animal patient. However, in light of Simor's teaching that MRI imaging techniques are useful for the detection of underperfused myocardium, the instant claim is within the scope of the claims of the '849 patent.

Claim 27 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 17 - 19 of U.S. Patent No. 6,063,361 in view of Platzek *et al.* (US 5,364,614). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant cascade

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polymers are the same as those of the '361 patent (claim 1) which are utilized in a method for diagnostic radiology which comprises administering to a patient at least one cascade polymer and subjecting the patient to a radiology diagnosis (claim 17). More specifically, the radiology diagnosis is computer tomography imaging (claim 19). The '361 patent does not specifically teach that performing an angiography diagnosis would be useful for the diagnosis of vascular disease, however Platzek *et al.* teach the use of similar cascade polymers as x-ray diagnostic media (i.e. radiology diagnostics) for the recognition and localization of vascular disease (column 2, lines 31 – 45). Thus, the same cascade polymers were administered in the '361 patent and the instant claim, and the step of subjecting a patient to a radiology diagnosis is interpreted to be within the scope of the step of performing an angiography diagnosis on a patient.

Claim Objections

Claims 17 – 19 and 21 – 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 28 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 17. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Perhaps applicant intended for claim 28 to be dependent upon claim 27 rather than claim 16.

Conclusion


No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lhs



MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER